UNITED STATES PATENT AND TRADEMARK OFFICE

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.　　2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *30 September 2003* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

1.   This Office Action is responsive to the Application filed 09/30/2003.

Claim Objections

2.   Claims 1-2, 5, 8, 10-14, 16, and 20 are objected to because of the following informalities:

Regarding **claim 1**, in line 7 the words --of the-- should be inserted between "one" and "markup" to improve the clarity of the claim.

In addition, in line 7 the word "representation" should be deleted and replaced with the word --representations-- to improve the clarity of the claim.

Regarding **claim 2**, in line 1 the phrase --the step of-- should be inserted between "wherein" and "generating" to improve the clarity of the claim.

Regarding **claim 5**, in line 1 the phrase --the step of-- should be inserted between "wherein" and "associating" to improve the clarity of the claim.

In addition, in line 2, the word --the-- should be inserted between the words "associating" and "meta" to improve the clarity of the claim.

Regarding **claim 8**, in line 1 the phrase --the step of-- should be inserted between "wherein" and "transforming" to improve the clarity of the claim.

Regarding **claim 10**, in line 2, the word "of" should be deleted and replaced with the word --of:-- to improve the clarity of the claim.

Regarding **claim 11**, in line 1, the word "generic" should be deleted to improve the clarity of the claim.

Regarding **claim 12**, in line 5, it is suggested that the phrase "source document" be deleted to improve the clarity of the claim.

In addition, it is suggested that in line 7 the word "an" be deleted and replaced with the word --the--.

It is further suggested that in line 8 the phrase --of the-- be inserted between the words "one" and "markup" to improve the clarity of the claim.

Regarding **claim 13**, it is suggested that in line 4, the word "events;" be deleted and replaced with the phrase --at least one event;-- to improve the clarity of the claim.

It is further suggested that in line 6, the word "events," be deleted and replaced with the phrase --at least one event,-- to improve the clarity of the claim.

It is additionally suggested that in line 6, the word "an" be deleted and replaced with the word --the-- to improve the clarity of the claim.

It is also suggested that in line 8, the phrase --of the one or more-- be inserted between "one" and "markup" to improve the clarity of the claim.

It is suggested that in line 8, the word "events" be deleted and replaced with the phrase --at least one event-- to improve the clarity of the claim.

Regarding **claim 14**, it is suggested that in line 1 the phrase "further comprising a server device" be deleted and replaced with the phrase --the server device further-- to improve the clarity of the claim.

Regarding **claim 16**, it is suggested that in line 2 the word "a" be deleted and replaced with the word --the-- to improve the clarity of the claim.

Regarding **claim 20**, it is suggested that in line 1 the phrase "the one or more filters are" be deleted and replaced with the phrase --the fragmentation filter is-- to improve the clarity of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 1**, which is directed to a method comprising the steps of generating, associating, transforming, sending, and receiving. In order for claimed subject matter to be statutory it must have a concrete, useful, and tangible result. In this case the result is concrete and useful but it is not tangible. The mere act of receiving an event from a client is not a tangible "real world" result as no data is stored for later use nor is anything made available to a user to be able to detect.

Claims 2-11 which are dependent upon claim 1 do not add any tangible result and thus are rejected for the same.

Regarding **claim 12**, which is directed to a method comprising the steps of generating, associating, transforming, sending, and receiving. In order for claimed subject matter to be statutory it must have a concrete, useful, and tangible result. In this case the result is concrete and useful but it is not tangible. The mere act of receiving an

event from a client is not a tangible "real world" result as no data is stored for later use

nor is anything made available to a user to be able to detect.

Regarding **claim 13**, which is directed to an apparatus comprising a server

device configured to perform the steps of generating, associating, transforming,

sending, and receiving. In order for claimed subject matter to be statutory it must have

a concrete, useful, and tangible result. In this case the result is concrete and useful but

it is not tangible. The mere act of receiving an event from a client is not a tangible "real

world" result as no data is stored for later use nor is anything made available to a user

to be able to detect.

Claim 14, which is dependent on claim 13 fails to add any tangible result to

subject matter and is thus rejected for the same.

Regarding **claim 15**, which is directed to an apparatus comprising an adaptation

framework. In order for a claim to be statutory it must be directed to a process, machine,

article of manufacture or composition of matter. Claim 15 lacks any statutory structure

as it merely recites a software program, a statutory category since it is clearly not a

series of steps or acts to constitute a process, not a mechanical device or combination

of mechanical devices to constitute a machine, not a tangible physical article or object

which is some form of matter to be a product and constitute a manufacture, and not a

composition of two or more substances to constitute a composition of matter.

In addition, the claimed subject matter must have a useful, concrete and tangible

result in order to be statutory. In this case the subject matter has a useful and concrete

result but it is not tangible. The mere act of fragmenting a document is not a "real world"

result as nothing is made available for use by a user nor is a result stored anywhere for

use.

Claims 16-21, which are dependent upon claim 15 fail to add any statutory

subject matter to the claim and therefore are rejected for the same.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 2, and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated

by Schwerdtfeger et al. (US 6829746), hereafter Schwerdtfeger.

Regarding **claim 1**, Schwerdtfeger discloses:

A method comprising:

generating a source document (electronic document 12, which inherently

must be generated in order to exist), the source document including at least one

event (Col 6, lines 40-45 describe that the source document contains elements,

and Col 9, lines 33-42 describe that the elements may include events from

JAVAscript such as mouseover events.);

associating meta information with one or more of the events; (Col. 9 lines

40-42 describe that the event is associated with an element (i.e. metadata).)

transforming the events into one or more markup language specific

representations of the events (Col 6, lines 53-66 describe that a DOM previously

generated is transformed into a scripting language understood by the client, e.g.

a subset of HTML, XML, Postscript, PDF, or AFP), the transformation of an event

being controlled at least in part by the associated meta-information; (Col 9, lines

40-45 state that the script includes the element and the identifier assigned to the

element, thus the transformation is controlled by the metadata that it is

associated with (the element and its identifier).

sending at least one markup language specific representation of the

events to a browser running on a client device (Col. 7 lines 7-8 state that the

transformed script is sent to the user agent of the client machine.); and

receiving from the client device one or more markup language specific

events coded as HTTP-request parameters. (Col. 7, lines 36-38 states that the

client device provides an event with an element and identifier to the transcoder

device. Col 8, lines 40-42 state that the HTTP 1.1 standard is used for

communication between the client and transcoder proxy.)

Regarding **claim 2 and as applied to claim 1**, Schwerdtfeger discloses:

wherein generating the source document comprises generating the source

document to include at least one generic, markup language independent, event.

(Javascript is generic and markup language independent as it can be used with

HTML and XML.)

Regarding **claim 3 and as applied to claim 1**, Schwerdtfeger discloses:

wherein the source document is a web document. (Col 6, lines 23-26 list web document formats as possible formats for the source document making the source document a web document.)

Regarding **claim 8 and as applied to claim 1**, Schwerdtfeger discloses:

transforming the events comprises automatically transforming the events. (Col. 6 lines 35-37 state that the transformation begins automatically after the server provides the document.)

Regarding **claim 10 and as applied to claim 1**, Schwerdtfeger discloses:

wherein the one or more markup language specific representations comprise one or more of an HTML representation, a WML representation, and a cHTML representation. (Col 6, lines 53-66 describe that the DOM previously generated is transformed into a scripting language understood by the client, e.g. a subset of HTML, XML, Postscript, PDF, or AFP. HTML, WML, and cHTML are all subsets of HTML.)

Regarding **claim 11 and as applied to claim 1**, Schwerdtfeger discloses:

wherein the generic events comprise one or more of a navigation event, an input event, a relation event, and a submission event. (A DOM supports many events, however, in Col. 9 lines 33-36 a mouse over event is specifically disclosed as an example, which is an input event.)

Regarding **claim 13**, Schwerdtfeger discloses:

An apparatus comprising:

a server device (interim server 26) configured to:

generate a source document, the source document including at

least one generic, markup language independent, event (Col. 6, lines 35-

37 state that a pre-transcoded DOM is created, lines 40-45 state that the

pre-transcoded DOM has methods of accessing and manipulating the

document, which are events. A DOM event is inherently markup language

independent.);

associate meta information with one or more of the events; (Col. 9

lines 41-43 state that the mouseover event Javascript code (metadata) is

associated with the element (event).)

transform the events into one or more markup language specific

representations of the events, the transformation of an event being

controlled at least in part by the associated meta- information (Col. 6, lines

53-63 describe how a script is generated from the original document. Col.

9, lines 46-50 state that during the transcoding the script may include

information about the code of a JavaScript event, thus the transformation

is controlled by the metadata associated with the event, because the code

will be associated with the element in the script);

send at least one markup language specific representation of the

events to a browser running on a client device (Col. 7, lines 7-8 state that

the script is provided to the client machine); and

receive from the client device one or more markup language

specific events coded as HTTP-request parameters. (Col. 7 36-37 state

that events are returned to the transcoder proxy (i.e. interim server 26),

Col. 8 lines 40-44 state that HTTP 1.1 is used to communicate between

the server and client.)

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Schwerdtfeger as applied to claims 1 and 3 above, and further in view of McCarron et

al. ("XML Events: An Events Syntax for XML"), hereafter McCarron.

Schwerdtfeger discloses all the limitations of claim 4 except for the event

being described in a generic, device-independent document description language

based on XML and that metadata is manually associated with the event.

The general concept of describing events in a generic, device-

independent document description language based on XML is well known in the

art as taught by McCarron (which discloses modifying XML to generically

describe events).

The general concept of manually associating metadata with an event is

well-known in the art as taught by McCarron (Section 2.2 describes attaching

attributes to observer elements (i.e. events)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Schwerdtfeger with the general concept of a generic, device-independent document description language based on XML and the general concept of manually associating metadata with an event as taught by McCarron in order to "provide an interoperable way of associating behaviors with document-level markup." (McCarron, Abstract lines 3-4.)

8.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwerdtfeger as applied to claim 1 above, and further in view of Musciano et al. (HTML: the Definitive Guide), hereafter Musciano.

Schwerdtfeger discloses all the limitations of claim 6 except for metadata including multiple respresentations of one element.

The general concept of metadata including alternate representations of an element is well known in the art as taught by Musciano (pg. 134, section 5.2.6.3, the alt attribute is metadata for a image that can be used in cases where a browser cannot display images, in other words a different representation of the image.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Schwerdtfeger with the general concept of metadata including alternate representations of an element as taught by Musciano in order to allow the user to have some indication of what is missing when an image cannot be displayed. (Musciano, Last line of page 134)

9.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwerdtfeger as applied to claim 1 above, and further in view of McCauley et al. (US 6434578), hereafter McCauley.

Schwerdtfeger discloses all the limitations of claim 7 except for meta-information enables elements to be declared to be optional and to be omitted on a client device with insufficient resources.

The general concept of meta-information enabling data processing decisions is well known in the art as taught by McCauley (Fig. 9, Fig. 12, Fig. 13, Col. 11 lines 57-67, Col 12 lines 1-38 teach that based off of the meta-information in Fig. 9, the result is processed differently depending upon client resources (i.e. the image is omitted as non-essential in the low speed connection case of Fig. 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method of Schwerdtfeger with the general concept of meta-information enabling data processing decisions as taught by McCauley in order to be more efficient (McCauley Col 2, lines 33-36).

10.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwerdtfeger and McCarron.

Regarding claim 12, Schwerdtfeger discloses:

A method comprising:

generating a source document, the source document including at least one generic, markup language independent, event; (Col 6, lines 40-45 describe

that the source document contains elements, and Col 9, lines 33-42 describe that

the elements may include events from JAVAscript such as mouseover events.

Javascript is generic and markup language independent as it can be used with

HTML and XML.)

automatically transforming the source document generic events into one

or more markup language specific representations of the source document

events, (Col 6, lines 53-66 describe that a DOM previously generated is

transformed into a scripting language understood by the client, e.g. a subset of

HTML, XML, Postscript, PDF, or AFP. Col. 6 lines 35-37 state that the

·transformation begins automatically after the server provides the document.) the

transformation of an event being controlled at least in part by the associated

meta-information; (Col 9, lines 40-45 state that the script includes the element

and the identifier assigned to the element, thus the transformation is controlled

by the metadata that it is associated with (the element and its identifier).

sending at least one markup language specific representation of the

events to a browser running on a client device (Col. 7 lines 7-8 state that the

transformed script is sent to the user agent of the client machine.); and

receiving from the client device one or more markup language specific

events coded as HTTP-request parameters. (Col. 7, lines 36-38 states that the

client device provides an event with an element and identifier to the transcoder

device. Col 8, lines 40-42 state that the HTTP 1.1 standard is used for

communication between the client and transcoder proxy.)

Schwerdtfeger discloses all the limitations of claim 12 except for manually associating metadata with the event.

The general concept of manually associating metadata with an event is well-known in the art as taught by McCarron (Section 2.2 describes attaching attributes to observer elements (i.e. events)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Schwerdtfeger with the general concept of manually associating metadata with an event as taught by McCarron in order to "provide an interoperable way of associating behaviors with document-level markup." (McCarron, Abstract lines 3-4.)

11.   Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwerdtfeger as applied to claims 1 and 13 above, and further in view of Halahmi (US 2003/0011631).

Schwerdtfeger discloses all the limitations of claims 9 and 14 except for fragmenting the document and transforming the fragments into language specific representations based off of limitations of a client device.

The general concept of fragmenting documents and processing them based off of device properties is well known in the art as taught by Halahmi (see Fig. 2, note that a specific representation of each delimited section (fragment) is created in step 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method of Schwerdtfeger with the general concept

of fragmenting documents and processing them based off of device properties as

taught by Huttunen in order to increase the speed of transmission of a document.

(Halahmi, [00026] lines 1-4)

12.   Claims 15-16, and 19-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over McCauley and Huttunen (US 2003/0069881).

Regarding claims 15-16 McCauley discloses:

An apparatus comprising:

an adaptation framework comprising:

an event dispatcher configured to process an incoming event

and control an invocation of one or more processes based upon the

event; (Dispatcher 40, the incoming event is a request for an

information page (see Col 6, lines 12-14) the dispatcher controls

the page renderers which are invoked based from the information

page information)

a fragment getter invoked by the event dispatcher and

configured to retrieve a portion of a document from a local data

store; (a fragment getter is inherent to provide the information page

to the rest of the system, otherwise the information page and its

information would not be able to be processed.)

a processor invoked by the event dispatcher and configured

to communicate with the fragment getter and configured to

transform the document into a device specific format (various page

renderers, one of which is invoked by the dispatcher to format the

page (Col. 6, lines 12-14)); and

a client recognizer configured to receive information from a

client device and to receive device profile information. (a client

recognizer is inherent to perform step 30 as defined in the first

paragraph of Col. 5, which discusses determining characteristics of

the client.)

McCauley discloses all the limitations of claims 15-16 and 19-21 except

for:

a fragmentation filter invoked by the event dispatcher configured to

fragment the document into one or more parts for display by a client

device based upon an availability of one or more resources at the client

device.

Huttunen teaches:

a fragmentation filter invoked by the event dispatcher configured to

fragment the document into one or more parts for display by a client

device based upon an availability of one or more resources at the client

device. ([0038] Partitioning agent 116 breaks the document into partitions

(fragments) based off of rules from the user device, including its

resources. See lines 30-33)).

the fragmentation filter further comprises:

a first fragmentation filter configured to manage caching of

one or more fragments of the document and configured to perform

a fragmentation of the document (Fig 4B, the node_subprocess

collects children and parent elements as it creates a fragment see

[0085]); and

a fragmentation validation filter communicating with the first

fragmentation filter configured to determine whether the fragments

may be rendered on the client device without exceeding the

resources of the client device, and if not, to enable further

fragmentation by the first fragmentation filter.

(check_big_block_subprocess 1500, which is used to determine

whether further fragmentation is necessary, if so it passes the

process back to various levels of processing, depending upon

where in fragmentation execution is. See [0096]- [0097] as an

example.)

a next filter to be executed is determined by a current filter being

executed. ([0091]-[0092] is one example of this where the is_header subprocess

controls whether processing continues to the previous subprocess filter ([0092]

lines 1-2) or whether it branches back to the node_subprocess filter to continue

processing on that level ([0092] lines 8-10).

the one or more filters are executed based upon filter configuration data

stored in a filter configuration file. (Note in [0038] lines 30-32 state that the

partitioning agent uses its own rules (filter configuration data) in addition to the annotation to perform fragmentation. It is inherent that these rules must be stored in a file.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of McCauley with partitioning agent taught by Huttunen in order to improve the accessibility and usability of documents (Huttunen, [0041] lines 1-2).

13.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCauley and Huttunen as applied to claim 15 above, and further in view of Reynolds et al. (CC/PP: A user side framework for content negotiation), hereafter Reynolds.

McCauley discloses generating a document, in Column 5, lines 14-17, where a document is converted into a stream document that is optimized for the requesting client. McCauley also discloses retrieving information from the client in the first paragraph of Column 5 as described in the above rejection of claim 16.

McCauley and Huttunen teach all the limitations of claim 17 except for the document being generated based upon user profile data.

Reynolds teaches a protocol that sends both user profile data and device profile data at the same time, note page 5, section 2 "Metadata and profiles" where the first set of items are user preferences.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify McCauley and Huttunen to include the protocol taught by

Reynolds in order to more enhance content negotiation speed. (Reynolds, page

4, section 1.2 line 2).

14.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over

McCauley and Huttunen as applied to claim 15 above, and further in view of

Schwerdtfeger.

McCauley and Huttunen teach all the limitations of claim 18 except for an

image filter.

Schwerdtfeger teaches an image filter in Col. 6, lines 66-67 and Col. 7

lines 1-4 (images from one format are converted to another format).

It would have been obvious to one of ordinary skill in the art at the time of

the invention to modify McCauley and Huttunen with the image filter as taught by

Schwerdtfeger in order to allow the display of multiple types of images.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael E. Keefer whose telephone number is (571)

270-1591. The examiner can normally be reached on Monday-Thursday 8am-5pm,

second Fridays 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Frantz Jules can be reached on (571) 270-1808. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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MEK 2/15/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER